

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PHUI QUI NGUYEN, KLAUS TAENNERT, and MARTIN WULF

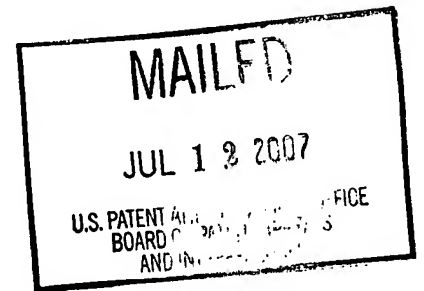
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Appeal 2007-0406  
Application 10/722,796  
Technology Center 1700

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REMAND TO THE EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences on November 18, 2006. Upon review of the application, it has been determined that a remand to the Examiner, via the Office of the Director of the Technology Center, is necessary to consider the following issue and to take necessary corrective action.

The Examiner's Answer (mailed July 27, 2006), cites US 6,384,125 (Bergstrom et al.), US 2004/0110856 (Young et al.), US 2002/0174924 (Zanzig et al.), US 2002/0140288 (Herberger, Sr.), US 2004/004414 (Linster et al.), US 6,156,578 (Tom), US 4,093,600 (Fan et al.) US 4,458,066 (Caruthers et al.), US 5,378,787 (Vrckovnik et al.) noted on pages 11, 14, and 17 of the Examiner's Answer under the headings **“(9) Grounds of Rejection”** and **“(10) Response to Argument.”** These reference *were not* included under the Section **“(8) Evidence Relied Upon”** as required.

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Before further review, the Examiner must mail a PTOL-90 that will include in the amended Evidence Relied Upon section, the list of references mentioned in the statement of rejections. *See the Manual of Patenting Examining Procedure (MPEP) § 1207.02.*

The Appeal Brief (filed June 8, 2006), cites on pages 14 and 15, various non patent literature documents (Owen MJ, Adv. Chem 224:705-39 (1990), West R. & Baney RH, J. Am. Chem. Soc. 81:6145-48 (1959), Lickiss PD, "The Synthesis and Structure of Organosilanols," Advances in Inorganic Chemistry, Sykes AG ed., vol. 42, pg. 147 (1995), Paint & Coatings Industry Magazine (available at: <http://www.pcimag.com/CDA/Archives/dedf9254f36a7010VgnVCM100000f932a8c0>), Baxter I et al., "Hydrogen Bonding to Silanols," Electronic Conference on Organometallic Chemistry, 1997) for which none were provided. It is required that Appellants supply these cited references in a Supplemental Appeal Brief under the Evidence Appendix heading for the Examiner's consideration. *See 37 CFR § 1.116, § 41.37, and § 41.39.*

Correction is hereby required.

Accordingly, this application is hereby *REMANDED* to the Examiner:

- (1) to issue and mail a PTOL-90 having the missing reference listed under the Evidence Relied Upon section, heading (8) of the Examiner's Answer;
- (2) to instruct Appellants to supply a Supplemental Appeal Brief with attached references cited on pages 14 and 15 of existing Appeal Brief of June 8, 2006 in accordance with the above instruction; and

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(3) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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